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## The Power of the Well-Known Trademark: Courts Should Consider Article 6BIS of the Paris Convention an Integrated Part of Section 44 of the Lanham Act

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## THE POWER OF THE WELL-KNOWN TRADEMARK: COURTS SHOULD CONSIDER ARTICLE 6BIS OF THE PARIS CONVENTION AN INTEGRATED PART OF SECTION 44 OF THE LANHAM ACT

Brandon Barker

*Abstract:* The Paris Convention for the Protection of Industrial Property outlines important international trademark principles for its signatory nations, including the United States. Specifically, article 6bis of the Paris Convention creates the well-known marks doctrine, a provision that allows foreign owners of well-known trademarks to bring infringement actions against citizens of other member nations using the same or similar trade names. Such foreign trademark holders can assert these rights regardless of whether their mark is directly used or registered in the native country of the alleged infringer. Although the Paris Convention provides a list of trademark rights within its articles, the convention itself is not self-executing and thus requires enacting legislation to give full legal effect to its principles. With the passage of the Lanham Act in 1946, Congress effectively codified federal trademark law and provided the sole statutory means by which trademark owners can assert their substantive rights in federal courts. The Lanham Act does not explicitly reference article 6bis, but it does strive to give full effect to the provisions of international conventions in order to afford foreign nationals protection from unfair competition. This Comment argues that a proper statutory construction of the Lanham Act requires that courts treat the well-known marks doctrine as an incorporated, codified piece of federal trademark law. The plain language of the Lanham Act, its legislative history, prior judicial considerations of relevant provisions of the Act, and the *Charming Betsy* canon support the conclusion that the Lanham Act integrates article 6bis and thus provides substantive rights for foreign well-known trademark owners.

A long-standing foreign cigar manufacturer sells its product for over forty years in its native country under the registered trademark “COHIBA.”<sup>1</sup> The cigar becomes internationally renowned and cigar magazines with large circulations in the United States give it the highest ranking possible.<sup>2</sup> After this distinction becomes widely recognized in the United States, an American manufacturer launches a new premium cigar under the same trade name.<sup>3</sup> The American company acknowledges that its new line of cigars is named COHIBA at least partly in response to the magazines’ coverage of the foreign brand.<sup>4</sup> The

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1. Hypothetical based on *Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d 462 (2d Cir. 2005).

2. See *Empresa Cubana del Tabaco*, 399 F.3d at 466.

3. See *id.*

4. See *id.*

foreign manufacturer does not conduct direct sales in the U.S. and their use of the COHIBA mark is not registered under federal trademark law.<sup>5</sup> Can the foreign manufacturer assert any substantive rights in U.S. courts to enjoin the American distributor from infringing on its well-known trademark?

Courts have not conclusively resolved the issue of whether federal law provides a means of protection for well-known foreign trademarks unregistered in the U.S.<sup>6</sup> The potential basis for such protection begins with the well-known marks doctrine found in article 6*bis* of the Paris Convention for the Protection of Industrial Property (Paris Convention),<sup>7</sup> an international treaty that dates back to 1883.<sup>8</sup> The Paris Convention, however, is not self-executing, and thus requires enacting legislation to give effect to its articles.<sup>9</sup> In 1946, Congress codified federal trademark law with the passage of the Lanham Act.<sup>10</sup> Although it does not explicitly codify the Paris Convention's well-known marks doctrine, section 44(b) of the Lanham Act provides that foreign claimants may be entitled to benefits arising from international conventions to which their native country and the U.S. are signatories.<sup>11</sup> Courts have struggled with the Lanham Act when determining the extent to which it incorporates the substantive rights included in such international conventions, particularly article 6*bis* of the Paris Convention.<sup>12</sup>

This Comment argues that U.S. courts should interpret the Lanham Act as incorporating article 6*bis* of the Paris Convention in order to provide trademark protections for qualified foreign litigants. The plain language of sections 44(b), (h), and (i) of the Lanham Act indicates that federal trademark law codifies articles of the Paris Convention and provides additional rights beyond those explicit in the Lanham Act.<sup>13</sup>

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5. See *id.* at 465.

6. See *id.*; see also *Grupo Gigante S.A. v. Dallo & Co. (Grupo Gigante II)*, 391 F.3d 1088, 1094 (9th Cir. 2004); *Almacenes Exito S.A. v. El Gallo Meat Mkt., Inc.*, 381 F. Supp. 2d 324, 326–28 (S.D.N.Y. 2005); *ITC v. Punchgini*, 373 F. Supp. 2d 275, 286–88 (S.D.N.Y. 2005).

7. Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter Paris Convention].

8. *Id.*

9. See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1158 (C.D. Cal. 1998).

10. See Trademark Act of 1946, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended in scattered sections of 15 U.S.C.).

11. See 15 U.S.C. § 1126(b) (2000).

12. See, e.g., *Grupo Gigante II*, 391 F.3d 1088, 1094 (9th Cir. 2004); *Almacenes Exito S.A. v. El Gallo Meat Mkt., Inc.*, 381 F. Supp. 2d 324, 326–28 (S.D.N.Y. 2005).

13. See 15 U.S.C. § 1126(b), (h)–(i); see also *Gen. Motors Corp. v. Ignacio Lopez de Arriortua*,

The Lanham Act's legislative history further reveals that Congress enacted the Act with a design toward executing the provisions of the Paris Convention.<sup>14</sup> Although limited case law exists, both federal and state courts have applied the well-known marks doctrine to provide protection to foreign litigants through the language of section 44 of the Lanham Act.<sup>15</sup> Courts have also attempted to interpret the Act in accordance with the *Charming Betsy* canon, which requires that courts interpret statutes in a manner that comports with international obligations.<sup>16</sup> Therefore, a proper statutory construction of the Lanham Act should incorporate article 6*bis* of the Paris Convention.

Part I of this Comment discusses the Paris Convention, the well-known marks doctrine, and the Lanham Act—the vehicle by which the articles of the Paris Convention may be asserted in the U.S. Part II provides an overview of the canons of statutory construction that courts must follow in their interpretation of statutes. Part III analyzes the Lanham Act's incorporation of international conventions in light of applicable principles of statutory interpretation. Part IV argues that a proper construction of the Lanham Act recognizes incorporation of the well-known marks doctrine as a substantive right available to claimants based on: (1) the plain language of the statute; (2) the legislative history of the statute; (3) prior judicial interpretations of the statute; and (4) the need to interpret the statute in accordance with international principles.

## I. THE PARIS CONVENTION CREATES THE WELL-KNOWN MARKS DOCTRINE BUT IS NOT SELF-EXECUTING

The establishment of the well-known marks doctrine took place in 1883 at the Paris Convention,<sup>17</sup> a meeting of nations that served to create the principal international treaty of trademark and unfair competition law.<sup>18</sup> The U.S., as a signatory nation, explicitly recognized the well-known marks doctrine by stipulating to article 6*bis* of the Paris

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948 F. Supp. 684, 689 (E.D. Mich. 1996).

14. See *Trademarks: Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents*, 76th Cong. 164 (1939).

15. See *Grupo Gigante II*, 391 F.3d at 1094; *Vaudable v. Montmartre*, 193 N.Y.S.2d 332, 334–36 (Sup. Ct. 1959).

16. See *In re Rath*, 402 F.3d 1207, 1211 (Fed. Cir. 2005); see also *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. (BNA) 909, 924 (T.T.A.B. 1984).

17. See Paris Convention, *supra* note 7.

18. See, e.g., 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:74 (4th ed. 2005).

Convention.<sup>19</sup> This article must be considered in accordance with the principle of territoriality, the basic notion that trademark rights and protections do not extend across international borders.<sup>20</sup> Since the Paris Convention is not a self-executing treaty and requires only reciprocal treatment among member nations, the precepts espoused at Paris provide trademark rights only to the extent that each country makes such guidelines functional by enacting its own substantive legislation.<sup>21</sup> In the U.S., the Lanham Act serves as the implementing legislation.<sup>22</sup> As a result, foreign mark holders may receive protection for well-known marks in federal courts only to the extent that the Lanham Act recognizes article 6bis of the Paris Convention.<sup>23</sup>

*A. The Well-Known Marks Doctrine Is an Integral Part of the Paris Convention and Is Considered the Law of the U.S. to the Extent Recognized by Statute*

The U.S. is a signatory nation to the Paris Convention.<sup>24</sup> Participating nations held this international conference in order to develop a framework for intellectual property protection.<sup>25</sup> The primary aim of the Paris Convention was to create an agreement between the signatory nations to provide reciprocal treatment with respect to intellectual property rights.<sup>26</sup> Thus, for example, citizens of France should receive the same trademark rights in the U.S. that federal law provides American citizens.<sup>27</sup> The resulting articles that emerged from the Paris Convention, and their subsequent amendments,<sup>28</sup> are considered the law of the U.S. only to the extent that they are recognized by enacted federal law.<sup>29</sup>

Article 6bis of the Paris Convention specifically provides protection for well-known marks across international borders when such marks are

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19. See *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633, 640 (2d Cir. 1956).

20. See, e.g., *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 599 (5th Cir. 1985).

21. See *Vanity Fair*, 234 F.2d at 640–41.

22. See 15 U.S.C. § 1126(b) (2000).

23. See *id.*

24. See, e.g., *Weil Ceramics & Glass, Inc. v. Dash*, 878 F.2d 659, 679 (3d Cir. 1989).

25. See Paris Convention, *supra* note 7, art. 1.

26. See *Vanity Fair*, 234 F.2d at 640.

27. See *id.* at 640–41.

28. See 4 MCCARTHY, *supra* note 18, § 29:22. The articles have been revised on six occasions since their inception in 1883, most recently in Stockholm in 1967, and amended in 1979. *Id.*

29. See *Vanity Fair*, 234 F.2d at 641.

“liable to create confusion” and are “used for identical or similar goods.”<sup>30</sup> Under the well-known marks doctrine, foreign nationals who use their trademarks in other countries can, if their marks are sufficiently famous, gain exclusive protection in the U.S.<sup>31</sup> This protection of well-known marks is strengthened by article 10*bis*, which provides that all acts by competitors in any of the member nations that serve to create trademark confusion or mislead the public about trademarked goods are strictly prohibited.<sup>32</sup>

*B. The Well-Known Marks Doctrine Can Be Interpreted Only in Accordance with the Territoriality Principle*

Protection of well-known marks must occur in conjunction with the territoriality principle, a longstanding concept basic to trademark law.<sup>33</sup> The territoriality principle recognizes that trademark rights exist in a particular country only in accordance with that nation’s laws.<sup>34</sup> Trademarks thus have a separate legal existence under each country’s laws. The primary concern, therefore, is the protection of the foreign trademark owner from infringement by others who may use the same or similar mark in domestic commerce.<sup>35</sup> The drafters of the Paris Convention included the concept of territoriality in the treaty.<sup>36</sup> Thus, under the territoriality principle, priority of trademark rights in the U.S. depends entirely on the development and use of the trademark in the U.S.; consideration is not necessarily accorded to competing trademark usage by foreigners.<sup>37</sup>

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30. Paris Convention, *supra* note 7, art. 6*bis* (“The countries of the Union undertake . . . to prohibit the use . . . of a trademark . . . liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion . . .”).

31. See *Grupo Gigante II*, 391 F.3d 1088, 1095 (9th Cir. 2004).

32. See Paris Convention, *supra* note 7, art. 10*bis*.

33. See, e.g., *Am. Circuit Breaker Corp. v. Or. Breakers Inc.*, 406 F.3d 577, 581 (9th Cir. 2005).

34. See, e.g., *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 599 (5th Cir. 1985).

35. See *Osawa & Co. v. B & H Photo*, 589 F. Supp. 1163, 1171 (S.D.N.Y. 1984).

36. See Paris Convention, *supra* note 7, art. 6(3) (“A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.”).

37. See 4 MCCARTHY, *supra* note 18, § 29:2. But see *id.* § 29:1 (noting that the foundation of U.S. trademark law embraced a universality theory, which asserted that trademarks lacked territorial

C. *The Paris Convention Does Not Create Substantive Law for Individual Nations and Enacting Legislation Is Needed to Give Effect to Its Provisions*

The Paris Convention does not create separate causes of action distinct from those provided under U.S. law.<sup>38</sup> The treaty states that it is not self-executing,<sup>39</sup> and federal courts have reached the same conclusion.<sup>40</sup> Its original aim was not to define unfair competition law within the signatory nations, but rather to provide fundamental standards that member countries would follow.<sup>41</sup> A foreign mark holder may in certain instances receive protection from trademark infringement or unfair competition in the U.S., but such protection must originate from federal law.<sup>42</sup> Thus, the articles of the Paris Convention are recognized only to the extent that federal law has made them operative by enacting legislation.<sup>43</sup>

D. *The Lanham Act Provides the Statutory Means by Which U.S. Courts Apply the Articles of the Paris Convention*

Congress codified federal trademark law in 1946 by passing the Lanham Act in order to provide federal protection for trademarks used in

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bounds and were capable of extension to any and all markets where the mark had gained recognition).

38. See *Kemart Corp. v. Printing Arts Research Labs., Inc.*, 269 F.2d 375, 389 (9th Cir. 1959).

39. See Paris Convention, *supra* note 7, art. 25 ("Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention. . . . It is understood that, at the time a country deposits its instrument of ratification or accession, it will be in a position under its domestic law to give effect to the provisions of this Convention."); see also *id.* art. 17; *French Republic v. Saratoga Vichy Spring Co.*, 191 U.S. 427, 438–39 (1903); *Mannington Mills, Inc. v. Congoleum Corp.*, 595 F.2d 1287, 1298–99 (3d Cir. 1979); 4 MCCARTHY, *supra* note 18, § 29:33.

A minority of courts have indicated that the Paris Convention is self-executing and provides a basis for a claim in federal court. See, e.g., *Benard Indus. Inc. v. Bayer Aktiengesellschaft*, 38 U.S.P.Q.2d (BNA) 1422, 1426 (S.D. Fla. 1996); *Davidoff Extension S.A. v. Davidoff Int'l, Inc.*, 612 F. Supp. 4, 8 (S.D. Fla. 1984). This debate is beyond the scope of this Comment, and the author assumes that the treaty is not self-executing.

40. See, e.g., *Int'l Café, S.A.L. v. Hard Rock Café Int'l (U.S.A.), Inc.*, 252 F.3d 1274, 1277 n.5 (11th Cir. 2001). But see *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633, 640 (2d Cir. 1956) (finding that the plaintiff may be correct in asserting that the Paris Convention is self-executing but does not create private rights for acts occurring in foreign countries).

41. See *Int'l Café*, 252 F.3d at 1277–78.

42. See *Vanity Fair*, 234 F.2d at 640–41.

43. See *id.*

interstate and foreign commerce.<sup>44</sup> The Lanham Act functions as the federal enacting legislation of the Paris Convention.<sup>45</sup> With its passage, Congress attempted to correct what it determined to be a domestic failure to enforce treaty obligations to protect intellectual property rights.<sup>46</sup> While the Lanham Act incorporates the Paris Convention, the international treaty does not create substantive rights beyond those independently provided in the federal statute.<sup>47</sup> Instead, the Paris Convention serves to enforce the principle that foreigners should be provided the same trademark protection as signatory nations provide their own citizens.<sup>48</sup> Congress' intention in meeting international obligations was to secure protection for U.S. trademark owners in foreign countries.<sup>49</sup>

In sum, article 6*bis* of the Paris Convention provides protection for foreign well-known mark holders. This protection, however, is limited by the territorial nature of trademark rights and the fact that the Paris Convention requires implementing legislation by signatory nations because the convention itself is not self-executing. In the U.S., the Lanham Act is the statutory mechanism by which the rights of the Paris Convention are enforced.

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44. See Trademark Act of 1946, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended in scattered sections of 15 U.S.C.).

45. See 15 U.S.C. § 1126(b) (2000).

46. See S. REP. NO. 79-1333, at 5 (1946), as reprinted in 1946 U.S. Code Cong. Serv. 1274, 1276.

47. See *Vanity Fair*, 234 F.2d at 640.

48. See *id.*

49. See S. REP. NO. 79-1333, at 1276; see also 15 U.S.C. § 1126(i). While not within the scope of this Comment, U.S. courts, prior to the passage of the Lanham Act, consistently provided redress for foreign well-known mark holders. See *Kerry v. Toupin*, 60 F. 272, 272-73 (D. Mass. 1894) (holding that a Canadian medicine manufacturer could bring a trademark infringement claim against a U.S. competitor by virtue of the Paris Convention); see also *Buckspan v. Hudson's Bay Co.*, 22 F.2d 721, 721-23 (5th Cir. 1927) (holding that a British fur trading company known in the U.S. for two centuries was entitled to protection against a Texas fur business operating under the same name); *La Republique Française v. Schultz*, 57 F. 37, 38-42 (S.D.N.Y. 1893) (holding that a French supplier of mineral water had a well-known trade name in the U.S. and could therefore enjoin a New York supplier from using the same name); *Maison Prunier v. Prunier's Rest. & Cafe*, 288 N.Y.S. 529, 530-31, 537-38 (Sup. Ct. 1936) (enjoining a New York restaurateur from the continued use of the same mark as a European restaurant chain that had developed worldwide goodwill through its use).



## II. U.S. COURTS INTERPRET FEDERAL STATUTES USING CERTAIN CANONS OF STATUTORY CONSTRUCTION

Courts use canons of statutory construction to determine the legislative intent underlying particular statutory language.<sup>50</sup> Courts begin their analysis by looking to the plain meaning of statutory text.<sup>51</sup> If the text is ambiguous, courts may also consider the legislative history of the statute<sup>52</sup> as well as prior judicial decisions that have considered the language at issue.<sup>53</sup> Lastly, courts attempt to interpret ambiguous statutes in a manner that gives full effect to relevant international considerations.<sup>54</sup>

### A. *Courts Begin Statutory Analysis by Looking to the Plain Language of a Statute*

When interpreting statutes, federal courts begin with the language enacted by Congress under the assumption that the plain meaning of such language conveys the legislative purpose of the statute.<sup>55</sup> Unless there is alternatively expressed legislative intent or ambiguity, courts will consider the ordinary meaning of the statutory language to be a complete and final articulation of the statute.<sup>56</sup> The meaning of a statute may be unambiguous even where the application of the statute is in dispute.<sup>57</sup> Even if the plain meaning of a statute is unambiguous, however, courts may also consider the particular language employed in the context of the entire statutory scheme, including other provisions of the statute.<sup>58</sup> In construing statutes, courts aim to give effect to every clause and word within the statutory text, thereby avoiding situations where certain words are rendered meaningless.<sup>59</sup>

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50. See, e.g., *Chickasaw Nation v. United States*, 534 U.S. 84, 94 (2001).

51. See, e.g., *Am. Tobacco Co. v. Patterson*, 456 U.S. 63, 68 (1982).

52. See, e.g., *Blum v. Stenson*, 465 U.S. 886, 896 (1984).

53. See, e.g., *Montgomery v. Huntington Bank*, 346 F.3d 693, 699 (6th Cir. 2003).

54. See, e.g., *Murray v. Schooner Charming Betsy*, 6 U.S. (2 Cranch) 64, 118 (1804).

55. See *Am. Tobacco Co.*, 456 U.S. at 68.

56. See, e.g., *Consumer Prod. Safety Comm'n v. GTE Sylvania, Inc.*, 447 U.S. 102, 108 (1980).

57. See OFFICE OF LEGAL POLICY, REPORT TO THE ATTORNEY GENERAL, USING AND MISUSING LEGISLATIVE HISTORY: A RE-EVALUATION OF THE STATUS OF LEGISLATIVE HISTORY IN STATUTORY INTERPRETATION iv (1989).

58. See, e.g., *Davis v. Mich. Dep't of Treasury*, 489 U.S. 803, 809 (1989).

59. See, e.g., *United States v. Menasche*, 348 U.S. 528, 538-39 (1955).

*B. Ambiguous Statutory Language Requires Courts to Consider Relevant Legislative History to Determine Congressional Intent*

In situations where statutory language is unclear, courts will ascertain the meaning of a particular provision by looking to its legislative history.<sup>60</sup> This investigation may include the circumstances surrounding the enactment of the statute, the legislative policy that the statute was designed to implement, and the statute's relationship to existing principles governing the same general subject matter.<sup>61</sup> For instance, in *NuPulse, Inc. v. Schlueter Co.*,<sup>62</sup> the U.S. Court of Appeals for the Seventh Circuit looked to the Lanham Act's legislative history to determine whether the court should utilize common law or statutory remedies when resolving a trademark claim for false designation of origin after determining that the plain language of the Act was ambiguous.<sup>63</sup> The court first considered Congress' general intentions in enacting the statute, and then examined a Senate report that spoke directly to the issue at hand.<sup>64</sup> The language of the Senate report prompted the court to rule that statutory remedies best effectuate Congressional intent.<sup>65</sup> By ascertaining and then applying Congress' will, courts can properly interpret otherwise unclear statutory language.

*C. Courts May Also Consider Prior Judicial Constructions when Analyzing the Meaning of Statutory Language*

Courts may consider past judicial constructions of statutory text in their interpretations of statutory language.<sup>66</sup> Courts consider similar judicial constructions of a given provision as one indication that its plain language is clear.<sup>67</sup> In instances of ambiguity, courts specifically emphasize considerations of past judgments when a conflict arises as to statutory construction because the legislature retains the power to effectively overrule the decisions of the courts.<sup>68</sup> In the trademark arena,

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60. See *Blum v. Stenson*, 465 U.S. 886, 896 (1984).

61. See *Blue Chip Stamps v. Manor Drug Stores*, 421 U.S. 723, 728–29, 731–32, 734–37 (1975).

62. 853 F.2d 545 (7th Cir. 1988).

63. See *id.* at 548–50.

64. See *id.* at 550.

65. See *id.*

66. See *Montgomery v. Huntington Bank*, 346 F.3d 693, 699 (6th Cir. 2003); see also *United States v. Herrera*, 289 F.3d 311, 320 (5th Cir. 2002).

67. See *Rickard v. Auto Publisher, Inc.*, 735 F.2d 450, 455 (11th Cir. 1984).

68. See, e.g., *Patterson v. McLean Credit Union*, 491 U.S. 164, 172–73 (1989).

courts look to how other jurisdictions have tackled similar Lanham Act claims, particularly those involving matters of first impression or limited instances of litigation in the past.<sup>69</sup> For example, in *Davidoff & CIE, S.A. v. PLD International Corp.*,<sup>70</sup> a case of first impression, the Eleventh Circuit looked successively to the plain language of the Lanham Act, its legislative history, and then to sister circuit rulings addressing the same issue in order to fashion a judgment under section 32 of the Act.<sup>71</sup>

*D. Courts Follow the Charming Betsy Canon and Interpret Ambiguous Statutory Language with an Emphasis on Meeting International Commitments*

Under the *Charming Betsy* canon, established in *Murray v. Schooner Charming Betsy*,<sup>72</sup> courts attempt to harmonize statutes with international obligations when statutory ambiguity exists.<sup>73</sup> While Congressional legislation is typically meant to apply only within the U.S.,<sup>74</sup> the Supreme Court has recognized extraterritorial application of federal statutes when Congress provides affirmative language to that effect.<sup>75</sup> Acts of Congress will trump international law only when such acts clearly conflict with international obligations and Congress passed the act after the ratification of the international treaty.<sup>76</sup> In all other situations, courts continue to follow the *Charming Betsy* canon, recognizing that “an act of congress ought never to be construed to violate the law of nations, if any other possible construction remains,”<sup>77</sup> even when the international agreement requires enacting legislation.<sup>78</sup>

In *Charming Betsy*, the Supreme Court had to determine whether

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69. See, e.g., *Davidoff & CIE, S.A. v. PLD Int'l Corp.*, 263 F.3d 1297, 1298–1302 (11th Cir. 2001); see also *Maday v. Toll Bros. Inc.*, 72 F. Supp. 2d 599, 601–02 (E.D. Va. 1999) (looking to prior circuit and district court rulings as relevant authority in deciding a Lanham Act statutory construction issue).

70. 263 F.3d 1297 (11th Cir. 2001).

71. See *id.* at 1298–1302.

72. 6 U.S. (2 Cranch) 64 (1804).

73. *Id.* at 118.

74. See, e.g., *EEOC v. Arabian Am. Oil Co.*, 499 U.S. 244, 248 (1991).

75. See *Sale v. Haitian Ctrs. Council, Inc.*, 509 U.S. 155, 176 (1993).

76. See *Breard v. Greene*, 523 U.S. 371, 376 (1998).

77. *Charming Betsy*, 6 U.S. (2 Cranch) at 118.

78. See, e.g., *McCulloch v. Sociedad Nacional de Marineros de Honduras*, 372 U.S. 10, 20–22 (1963); *Kane v. Winn*, 319 F. Supp. 2d 162, 196 (D. Mass. 2004).

federal violations of *jus cogens*<sup>79</sup> norms constituted a waiver of immunity.<sup>80</sup> The Court determined that a waiver was created, basing its decision on: (1) the fact that international law created such a waiver; and (2) recognition that the U.S. ought to avoid legal conflicts with international obligations.<sup>81</sup> Since *Charming Betsy*, the Court has continued to construe Congressional acts to avoid inconsistency with prior international provisions.<sup>82</sup> Unless Congress has indicated otherwise, courts should consider the doctrine of international comity when interpreting statutes.<sup>83</sup> Thus, courts aim to interpret applicable provisions in a manner consistent with international obligations.<sup>84</sup>

In sum, courts follow a prescribed set of rules in their construction of statutes. Unless the plain language is unambiguous, courts may consider legislative history in order to ascertain Congressional intent. Courts may also consider how prior judicial decisions have analyzed the statute at issue. Throughout this process, courts aim to interpret statutes in accordance with international law.

### III. THE LANHAM ACT PROVIDES FOR ENFORCEMENT OF INTERNATIONAL TREATY OBLIGATIONS

The express language of sections 44(b) and (h) of the Lanham Act aim to give effect to the provisions of international treaties.<sup>85</sup> Section 44(i) of the Lanham Act indicates that such treaties logically provide additional rights beyond those expressly specified in the Act's statutory text.<sup>86</sup> Upon looking beyond the express language of these sections, it becomes clear that Congress enacted them in order to execute international agreements as an exercise of the commerce power.<sup>87</sup> Courts have subsequently applied these relevant Lanham Act provisions in an

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79. "Jus cogens" is "[a] mandatory or peremptory norm of general international law accepted and recognized by the international community as a norm from which no derogation is permitted." BLACK'S LAW DICTIONARY 864 (8th ed. 2004).

80. See *Charming Betsy*, 6 U.S. (2 Cranch) at 66–67.

81. See *id.* at 118–21.

82. For a list of relevant cases, see RESTATEMENT (THIRD) OF FOREIGN RELATIONS § 114 (1987).

83. See, e.g., *In re Maxwell Comm'n Corp.*, 93 F.3d 1036, 1048 (2d Cir. 1996).

84. See *Fed. Mogul Corp. v. United States*, 63 F.3d 1572, 1581 (Fed. Cir. 1995); see also *United States v. Vasquez-Velasco*, 15 F.3d 833, 839–41 (9th Cir. 1994).

85. See 15 U.S.C. § 1126(b), (h) (2000).

86. See *id.* § 1126(i); see also *Gen. Motors Corp. v. Ignacio Lopez de Arriortua*, 948 F. Supp. 684, 689 (E.D. Mich. 1996).

87. See *Gen. Motors Corp.*, 948 F. Supp. at 690.

effort to provide protection for foreign trademark owners, both through the rights embodied in the Paris Convention<sup>88</sup> and other international treaties.<sup>89</sup> In accordance with the *Charming Betsy* canon, courts interpret the Lanham Act to comport with international law.<sup>90</sup>

*A. The Plain Language of Sections 44(b), (h), and (i) of the Lanham Act Effectuates the Provisions of the Paris Convention*

The ordinary meaning of sections 44(b), (h), and (i) of the Lanham Act provides foreign trademark owners with Paris Convention rights and remedies under federal law.<sup>91</sup> The language of the first two provisions unequivocally affirms that the Lanham Act is designed to incorporate the provisions of international treaties such as the Paris Convention.<sup>92</sup> Although courts have disputed the meaning of section 44(i), several jurisdictions have held that the plain language of the provision, read in conjunction with sections 44(b) and (h), indicates that incorporation of international conventions into the Lanham Act demonstrates congressional intent to recognize provisions of the Paris Convention as an integral part of the statute.<sup>93</sup>

*1. Sections 44(b) and (h) State that the Lanham Act Provides Benefits to Litigants Seeking Protection by Way of a Convention Provision*

Two provisions within the Lanham Act speak directly to the benefits held by foreigners whose countries are fellow signatories to the Paris Convention. First, section 44(b) provides that any foreign national whose country of origin is a party to any convention relating to trademarks to which the U.S. is also a party “shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention.”<sup>94</sup>

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88. *See Grupo Gigante II*, 391 F.3d 1088, 1094–95 (9th Cir. 2004).

89. *See, e.g., Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788, 792–93 (9th Cir. 1981).

90. *See, e.g., In re Rath*, 402 F.3d 1207, 1211 (Fed. Cir. 2005); *see also Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. (BNA) 909, 924 (T.T.A.B. 1984).

91. *See* 15 U.S.C. § 1126(b), (h)–(i).

92. *See id.* § 1126(b), (h); *Gen. Motors Corp.*, 948 F. Supp. at 689–90.

93. *See Gen. Motors Corp.*, 948 F. Supp. at 689–90; *see also Steele v. Bulova Watch Co.*, 344 U.S. 280, 283–86 (1952).

94. 15 U.S.C. § 1126(b); *accord* *Havana Club Holding, S.A. v. Galleon, S.A.*, 62 F. Supp. 2d 1085, 1093 n.7 (“As originally enacted, § 44(b) specifically referenced the International Convention for the Protection of Industrial Property (Paris Union) . . .”).

This section codifies international trademark agreements in federal law by providing certain foreigners with the advantages provided in such treaties.<sup>95</sup> Second, section 44(h) states that any person entitled to the benefits of section 44(b) “shall be entitled to effective protection against unfair competition, and the remedies provided in this chapter . . . shall be available so far as they may be appropriate.”<sup>96</sup> Section 44(h) guarantees foreign nationals the same protection against trademark infringement enjoyed by U.S. citizens, whether such protection emanates from federal or state law.<sup>97</sup> Thus, the ordinary meaning of these two subsections indicates that Lanham Act rights are extended to effectuate the purposes of international conventions.<sup>98</sup>

2. *Courts Disagree on Whether the Plain Language of Section 44(i) Suggests that the Lanham Act Provides Additional Rights Beyond Those Explicitly Enumerated in the Act’s Statutory Text*

Courts disagree on whether the plain language of section 44 of the Lanham Act implements the expansive prohibition against unfair competition found in the Paris Convention.<sup>99</sup> Some courts have stated that the Paris Convention, although recognized by the Lanham Act, does not provide substantive rights beyond those specifically enumerated by Congress.<sup>100</sup> These courts conclude that section 44 extends only existing Lanham Act and state law protections to foreigners engaged in commerce in the U.S.<sup>101</sup> Other courts, however, have noted that the Lanham Act incorporates international agreements and in some cases incorporates the provisions of such agreements to create a federal body of unfair competition law that is applicable in cross-border disputes.<sup>102</sup>

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95. See *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633, 643–44 (2d Cir. 1956).

96. 15 U.S.C. § 1126(h).

97. See *id.*

98. See, e.g., *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788, 792–93 (9th Cir. 1981).

99. *Eli Lilly & Co. v. Roussel Corp.*, 23 F. Supp. 2d 460, 481–82 (D.N.J. 1998) (noting this disagreement).

100. See, e.g., *Vanity Fair*, 234 F.2d at 640–41; see also *In re Compagnie Generale Mar.*, 993 F.2d 841, 850 (Fed. Cir. 1993) (Nies, C.J., dissenting); *Majorica, S.A. v. Majorca Int’l, Ltd.*, 687 F. Supp. 92, 95–96 (S.D.N.Y. 1988).

101. See, e.g., *Vanity Fair*, 234 F.2d at 640; *L’Aiglon Apparel, Inc. v. Lana Lobell, Inc.*, 214 F.2d 649, 652 (3d Cir. 1954).

102. See, e.g., *Gen. Motors Corp. v. Ignacio Lopez de Arriortua*, 948 F. Supp. 684, 688–89 (E.D. Mich 1996) (holding that a U.S. company may receive Lanham Act and Paris Convention protection from unfair competition occurring outside of the U.S.); see also *Laboratorios Roldan, C. por A. v. Tex Int’l, Inc.*, 902 F. Supp. 1555, 1568–69 (S.D. Fla. 1995) (holding that a Dominican company

These latter courts interpret the Lanham Act in a manner dictated by the statute's underlying purpose of providing rights and remedies stipulated by prior international conventions.<sup>103</sup> Courts have partially justified this approach by looking to section 44(i), which accords U.S. citizens the same rights that foreign nationals receive under section 44(b).<sup>104</sup> Courts have interpreted the language of this provision to indicate that Congress drafted section 44(i) in order to make clear that the incorporation of international agreements such as the Paris Convention provides additional rights for U.S. citizens,<sup>105</sup> and by extension, those foreigners whose countries are signatory nations.<sup>106</sup> In other words, it would have been unnecessary for Congress to include section 44(i) in the Lanham Act unless the incorporation of international treaties entitled Lanham Act claimants to rights not explicit in the statutory language.<sup>107</sup> These jurisdictions have concluded that the alternative reading of section 44(b)—to require only national treatment—would render section 44(i) superfluous and thus fail to give full effect to every provision of the statute.<sup>108</sup>

*B. Congress Enacted Sections 44(b) and (h) with a Design Toward Providing Foreign Trademark Owners with Additional Means of Protection*

Congress understood from the outset that the Paris Convention provided more extensive protection against unfair competition than the Lanham Act.<sup>109</sup> Initially, members of Congress were concerned that enacting a broad federal prohibition against unfair competition would be

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may receive Lanham Act protection from unfair competition).

103. See 15 U.S.C. § 1126 (2000); *Gen. Motors Corp.*, 948 F. Supp. at 689; *Maison Lazard et Compagnie v. Manfra, Tordella & Brooks, Inc.*, 585 F. Supp. 1286, 1289 (S.D.N.Y. 1984).

104. See *id.* § 1126(i) ("Citizens or residents of the United States shall have the same benefits as are granted by this section to persons described in subsection (b) of this section."); *Gen. Motors Corp.*, 948 F. Supp. at 689; *Maison Lazard*, 585 F. Supp. at 1289 (holding that section 44 of the Act provides rights and remedies consistent with unfair competition treaties).

105. *Gen. Motors Corp.*, 948 F. Supp. at 689; *Maison Lazard*, 585 F. Supp. at 1289.

106. *Id.*

107. *Id.*

108. *Id.*

109. See *Trademarks*, *supra* note 14 ("We have the curious anomaly of this Government giving by treaty [Paris Convention] and by law with respect to trade-marks and unfair competition to nationals of foreign governments greater rights than it gives to its own citizens.") (statement of Edward S. Rogers, Attorney).

dangerous.<sup>110</sup> However, Congress reversed its position during the legislative process and ultimately enacted section 44(h) to provide foreigners with valuable protections.<sup>111</sup> Such an about face is consistent with Congress' belief that it should execute the articles of the Paris Convention completely.<sup>112</sup> Congress has the power to regulate foreign commerce when such activities have a substantial effect on commerce between the U.S. and foreign nations.<sup>113</sup> Coupling section 44(h) with Congress' ability to affect foreign commerce has led to the determination that the Lanham Act has extraterritorial reach.<sup>114</sup> Recent amendments to sections 44(b) and (h) of the Lanham Act also provide that the relationship between the statute and the Paris Convention should be left unaffected.<sup>115</sup>

*C. Courts Have Disagreed as to Whether the Lanham Act Protects Foreigners with Well-Known Marks but Have Read Similar International Treaties into the Act*

Since the inception of the Lanham Act in 1946, U.S. courts have afforded Lanham Act protection to foreign well-known mark holders by relying on the language of article 6bis of the Paris Convention.<sup>116</sup> After the codification of federal trademark law, a New York state court reaffirmed that foreign well-known mark holders may receive trademark protection in the U.S.<sup>117</sup> More recently, federal courts have disagreed as to whether the Lanham Act incorporates article 6bis of the Paris Convention as a substantive right.<sup>118</sup> The Ninth Circuit has held that a

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110. See *id.* at 165–68.

111. See 15 U.S.C. § 1126(h) (2000); *Gen. Motors Corp.*, 948 F. Supp. at 690.

112. See *Gen. Motors Corp.*, 948 F. Supp. at 690; see also *Trademarks*, *supra* note 14.

113. Cf. *Consol. Gold Fields PLC v. Minorco, S.A.*, 871 F.2d 252, 261–62 (2d Cir. 1989).

114. See, e.g., *Steele v. Bulova Watch Co.*, 344 U.S. 280, 283–86 (1952) (holding that the Lanham Act was designed to provide courts with expansive powers of jurisdiction, including, in certain circumstances, extraterritorial activities).

115. See S. REP. NO. 100-515, at 43 (1988), as reprinted in 1988 U.S.C.C.A.N. 5577, 5606 (“These amendments will not affect U.S. obligations under the Paris Convention . . .”).

116. See Paris Convention, *supra* note 7, art. 6bis; *Grupo Gigante II*, 391 F.3d 1088, 1094 (9th Cir. 2004); *Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. (BNA) 909, 924 (T.T.A.B. 1984).

117. See *Vaudable v. Montmartre, Inc.*, 193 N.Y.S.2d 332, 334–36 (Sup. Ct. 1959).

118. Compare *Grupo Gigante II*, 391 F.3d at 1094, with *Almancenex Exito S.A. v. El Gallo Meat Mkt. Inc.*, 381 F. Supp. 2d 324, 327 (S.D.N.Y. 2005). While the Ninth Circuit holds that foreign trademark owners may bring a Lanham Act claim under the principles of the well-known marks doctrine, the Southern District of New York holds that no such substantive right exists under the



similar international trademark treaty provides substantive Lanham Act rights for foreign claimants.<sup>119</sup>

1. *Vaudable Supports the Validity of the Well-Known Marks Doctrine Following the Codification of Federal Trademark Law*

*Vaudable v. Montmartre, Inc.*,<sup>120</sup> a 1959 trial court decision from New York, strengthened the significance of the well-known marks doctrine as the first case to apply the well-known marks doctrine after the inception of the Lanham Act. In *Vaudable*, a New York restaurant began operating under the name "Maxim's," the same name as a well-known Parisian restaurant in operation since 1893.<sup>121</sup> The New York restaurant used similar script for its sign and included other features designed to evoke the images and expectations that had come to be associated with the elite French restaurant.<sup>122</sup> The *Vaudable* court enjoined the marks at issue from being used in New York because it was unmistakably clear that the New York establishment aimed to appropriate the goodwill of a restaurant with international recognition.<sup>123</sup> It did this in light of the fact that the marks associated with the Paris Maxim's were well-known, even though the Parisian restaurant did not register its mark under the Lanham Act or directly engage in business in the U.S.<sup>124</sup> Moreover, the *Vaudable* court noted that the scope of protection available against unfair competition had only increased over time as a result of case law and legislation such as the Lanham Act.<sup>125</sup> Thus, the *Vaudable* court held that trademark owners who use their marks exclusively in foreign countries could on occasion receive sole rights to a particular mark in the U.S. if the mark meets an ambiguous "well-known" threshold.<sup>126</sup>

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language of the Act.

119. See *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788, 792-93 (9th Cir. 1981).

120. 193 N.Y.S.2d 332 (Sup. Ct. 1959).

121. See *id.* at 334. The Paris "Maxim's" had been the subject of many articles in periodicals and mentioned in both movies and television. *Id.* The court determined that the Parisian restaurant would be well-known to New York City restaurant-goers. *Id.*

122. See *id.*

123. See *id.* at 335.

124. See *id.* at 335-36.

125. See *id.* at 335 ("The trend of the law, both statutory and decisional, has been to extend the scope of the doctrine of unfair competition . . .").

126. See *id.* at 334-35.

2. *Courts Have Recently Disagreed as to Whether the Lanham Act Incorporates the Well-Known Marks Doctrine as a Statutory Right*

Recently, federal courts have reached differing results when litigants have brought Lanham Act claims arising from the language of article 6bis of the Paris Convention.<sup>127</sup> The Ninth Circuit has held that the well-known marks doctrine is an existing component of federal trademark law that may be utilized in limited situations.<sup>128</sup> Conversely, the U.S. District Court for the Southern District of New York has held that article 6bis cannot provide the basis for a valid claim in federal court because the plain language of the Lanham Act does not explicitly provide for the protection of well-known marks.<sup>129</sup>

The Ninth Circuit recently implied that article 6bis of the Paris Convention provides a substantive right that may be enforced through section 44 of the Lanham Act.<sup>130</sup> In *Grupo Gigante v. Dallo & Co.*,<sup>131</sup> a Mexican grocery store chain sued a California grocery store for infringement of its “Gigante” trademark, relying on the language of both the Lanham Act and the Paris Convention.<sup>132</sup> After recognizing the well-known marks doctrine, the court reasoned that, without that doctrine, territoriality would be completely unqualified and consumer confusion and fraud would prevail.<sup>133</sup> In its justification of the doctrine, the *Grupo Gigante* court echoed some of the language of the *Vaudable* court.<sup>134</sup> Specifically, the Ninth Circuit remarked that both commerce and people frequently cross borders in the twenty-first century and, as a result, protection of marks necessitates looking beyond national borders.<sup>135</sup>

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127. Compare *Grupo Gigante II*, 391 F.3d 1088, 1099 (9th Cir. 2004) (finding that the rights outlined under article 6bis may be asserted under section 44(b) of the Lanham Act), with *Almancenex Exito S.A. v. El Gallo Meat Market, Inc.*, 381 F. Supp. 2d 324, 327–28 (S.D.N.Y. 2005) (holding that section 44(b) does not incorporate the language of article 6bis).

128. See *Grupo Gigante II*, 391 F.3d at 1094–98.

129. See *Almancenex Exito S.A.*, 381 F. Supp. 2d at 327.

130. See *Grupo Gigante II*, 391 F.3d at 1099.

131. 391 F.3d 1088 (9th Cir. 2004).

132. *Id.* at 1092.

133. See *id.* at 1094.

134. See *id.* at 1094–95 (noting that even those mark owners who use their marks in other countries can sometimes gain exclusive rights to the marks in the U.S., if the mark has achieved a high degree of fame here).

135. See *id.* at 1094 (“There can be no justification for using trademark law to fool immigrants into thinking that they are buying from the store they liked back home.”); see also *Grupo Gigante S.A. de C.V. v. Dallo & Co. (Grupo Gigante I)*, 119 F. Supp. 2d 1083, 1090 (C.D. Cal. 2000) (noting that the well-known marks doctrine “recognizes the realities of modern society and business

The *Grupo Gigante* court limited the well-known marks doctrine to comport with the concept of territoriality.<sup>136</sup> In the lower court decision, the Central District of California interpreted Grupo Gigante's use of the mark exactly as it would have had Grupo Gigante used the mark not only in Mexico, but also in another part of the U.S.<sup>137</sup> Therefore, the relevant inquiry became simply whether or not Grupo Gigante had acquired secondary meaning<sup>138</sup> in the California market.<sup>139</sup> In concert with early cases discussing the doctrine, the Ninth Circuit rejected the lower court's interpretation due to concern that such a broad application of the doctrine would effectively whittle away the concept of territoriality.<sup>140</sup> Instead, the Ninth Circuit, as the first appellate court to apply the well-known marks doctrine,<sup>141</sup> created a high threshold for litigants to meet in order to invoke its protections.<sup>142</sup> The court noted that the Lanham Act claim brought by the foreign mark holder was duplicative of the alternative claim brought under article 6*bis* of the Paris Convention.<sup>143</sup> Thus, the *Grupo Gigante* court concluded that the Lanham Act incorporated article 6*bis* in light of the fact that the Paris Convention does not give rise to any federal causes of action or other substantive rights.<sup>144</sup>

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by acknowledging the fact that a trademark can be carried to areas far from the actual point of sale due to advertising and the ambulatory nature of consumers"), *vacated*, 391 F.3d 1088 (9th Cir. 2004).

136. See *Grupo Gigante II*, 391 F.3d at 1097–98.

137. See *Grupo Gigante I*, 119 F. Supp. 2d at 1091 (noting that the relevant inquiry was whether "the mark was sufficiently known to potential customers in the area of the United States where it seeks protection"). The court did not consider whether the mark actually qualified as "well-known."

138. See, e.g., *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938) (noting that to establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself).

139. See *Grupo Gigante II*, 391 F.3d at 1097.

140. See *id.* at 1097–98.

141. See *id.* at 1094. For a recent judicial decision that implicitly recognizes the doctrine as a part of the Lanham Act, see *ITC v. Punchgini, Inc.*, 373 F. Supp. 2d 275, 286–89 (S.D.N.Y. 2005) (finding that the doctrine may have been asserted by the plaintiff through a Lanham Act claim, but ultimately declining to reach the issue because the foreign mark, as an initial matter, had not acquired secondary meaning).

142. See *Grupo Gigante II*, 391 F.3d at 1098. The Ninth Circuit created a two-prong test for litigants to pass in order to receive protection under the doctrine. *Id.* The moving party must (1) demonstrate that the mark has developed secondary meaning; and (2) prove that a substantial percentage of consumers in the relevant American market are familiar with the foreign mark. *Id.*

143. See *id.* at 1099.

144. See *id.*

In apparent conflict with *Grupo Gigante*, the Southern District of New York recently determined that the well-known marks doctrine does not apply to federal trademark law.<sup>145</sup> In *Almacenes Exito S.A. v. El Gallo Meat Market, Inc.*,<sup>146</sup> a Colombian retailer brought federal and state law claims against a grocery store operator in the U.S., alleging infringement of the “EXITO” trademark.<sup>147</sup> The court found the doctrine inapplicable to federal law claims because Congress developed the Lanham Act to handle all federal trademark claims and the statute does not explicitly include the well-known marks doctrine.<sup>148</sup> The court rejected the plaintiff’s argument that the well-known marks doctrine was a part of the Lanham Act by incorporation of article 6bis of the Paris Convention.<sup>149</sup> Rather, the district court determined that while the Lanham Act to some degree incorporated the articles agreed upon in Paris, the articles did not grant substantive rights beyond those provided by the plain language of the federal statute.<sup>150</sup> The *Almacenes Exito* court distinguished *Grupo Gigante* as based strictly on policy rather than statutory grounds.<sup>151</sup> While the court admitted that the well-known marks doctrine may support state law claims,<sup>152</sup> it concluded that Congress would need to codify a new provision in the Lanham Act in order for the doctrine to have effect in federal courts.<sup>153</sup>

The *Almacenes Exito* court partially justified its decision by relying on *Empresa Cubana Del Tabaco v. Culbro Corp.*<sup>154</sup> In that case, the Second Circuit implicitly recognized the well-known marks doctrine, noting that article 6bis may be implied in certain Lanham Act provisions.<sup>155</sup> The Second Circuit did not allow the plaintiff to seek

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145. See *Almacenes Exito S.A. v. El Gallo Meat Mkt., Inc.*, 381 F. Supp. 2d 324, 327 (S.D.N.Y. 2005).

146. 381 F. Supp. 2d 324 (S.D.N.Y. 2005).

147. See *id.* at 325–26.

148. See *id.* at 327–28.

149. See *id.* at 327.

150. See *id.* at 328; see also *Int’l Café, S.A.L. v. Hard Rock Café Int’l (U.S.A.), Inc.*, 252 F.3d 1274, 1278 (11th Cir. 2001) (finding that the Paris Convention does not create substantive rights beyond those independently provided in the Lanham Act).

151. See *Almacenes Exito S.A.*, 381 F. Supp. 2d at 328.

152. See *id.* at 327.

153. See *id.* at 328.

154. 399 F.3d 462 (2d Cir. 2005).

155. See *id.* at 480 (“Cubatabaco may be correct that Sections 44(b) and (h) [of the Lanham Act] incorporate Article 6bis and allow foreign entities to acquire U.S. trademark rights in the United States if their marks are sufficiently famous in the United States before they are used in this

protection under the doctrine.<sup>156</sup> The decision was ultimately based on an embargo between the U.S. and Cuba, the plaintiff's country of origin, which prohibited the plaintiff from acquiring trademark rights in the U.S.<sup>157</sup> Thus, it was only under the special circumstances of an economic embargo that the Second Circuit refused to apply the doctrine.<sup>158</sup>

3. *The Ninth Circuit Has Determined that Rights Embodied in Other International Treaties May Be Enforced Through Section 44 of the Lanham Act*

In *Toho Co. v. Sears, Roebuck & Co.*,<sup>159</sup> the Ninth Circuit determined that the Treaty of Friendship, Commerce, and Navigation between the U.S. and Japan could provide a basis for a Japanese corporation to assert section 44 claims under the Lanham Act in federal court.<sup>160</sup> The foreign holder of the mark "Godzilla" brought claims against an American manufacturer of garbage bags that used the name "Bagzilla" in advertising.<sup>161</sup> The *Toho* court found that because Japan was a signatory nation to a trademark treaty with the U.S. that required the U.S. to provide trademark protection to Japanese nationals that was at least as favorable as the treatment accorded to American citizens,<sup>162</sup> a reading of section 44 in conjunction with the treaty at issue required U.S. courts to provide the Japanese mark holder a federal forum to pursue its claims.<sup>163</sup> Under the court's reasoning, section 44 mandates that federal courts apply international treaty provisions in order to determine whether

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country."'). *But see* *Int'l Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 389 n.9 (4th Cir. 2003) (Motz, J., dissenting) ("[The well-known marks] doctrine has been applied so seldom . . . that its viability is uncertain.").

156. *See Empresa Cubana Del Tabaco*, 399 F.3d at 481.

157. *See id.*

158. *See id.* ("We do not read Article 6bis and Section 44(b) and (h) of the Lanham Act to require cancellation of General Cigar's properly registered trademark or an injunction against its use of the mark in the United States *under these circumstances*."') (emphasis added).

159. 645 F.2d 788 (9th Cir. 1981).

160. *See id.* at 792-93.

161. *See id.* at 789-90.

162. *See id.* at 792-93 ("The Treaty of Friendship, Commerce and Navigation, Apr. 2, 1953, United States-Japan, art. X, 4 U.S.T. 2063, 2071, T.I.A.S. No. 2863, requires the United States to accord Japanese nationals and companies treatment 'with respect to rights in trade marks . . . ' that is at least as favorable as (1) the treatment accorded nationals and companies of the United States and (2) that accorded to the nationals and companies of most favored nations."').

163. *See id.*

federal jurisdiction exists for the foreign mark holder.<sup>164</sup> Thus, the Ninth Circuit reasoned that an international treaty could provide a foreign mark holder with substantive Lanham Act rights under section 44.<sup>165</sup>

*D. Courts Interpret the Lanham Act in a Manner that Comports Federal Law with International Obligations*

When the plain language of the Lanham Act is susceptible to differing interpretations, courts aim to construe the statute in harmony with international law.<sup>166</sup> The Paris Convention is a “law of nations,” or customary international law, and therefore considered an international agreement for the purposes of the *Charming Betsy* canon.<sup>167</sup> The ratification of the Paris Convention predates the Lanham Act, and section 44 of the Lanham Act provides federal rights coextensive with the provisions of the Paris Convention.<sup>168</sup> The Federal Circuit recently employed the *Charming Betsy* canon in its interpretation of section 44 of the Lanham Act and its connection to the Paris Convention.<sup>169</sup> The Trademark Trial and Appeal Board, an administrative court, has also interpreted section 44 use requirements in an effort to promote consistency between the Lanham Act and the Paris Convention, finding that in instances of ambiguity the Board must apply the federal statute by fully recognizing the international provisions outlined in the Paris Convention.<sup>170</sup> Thus, courts harmonize the Lanham Act with the Paris Convention in order to maintain consistency with international trademark rights.<sup>171</sup>

In sum, the plain language of sections 44(b), (h), and (i) of the Lanham Act states that claimants under the statute may receive the benefits necessary to give effect to provisions of international treaties. The Lanham Act’s legislative history indicates that the Act was designed

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164. See *id.* at 792–93; see also *Litton Sys., Inc. v. Ssangyong Cement Indus. Co.*, No. 96-1034, 1997 WL 59360, at \*5 (Fed. Cir. Feb. 13, 1997).

165. See *Toho*, 645 F.2d at 792–93.

166. See, e.g., *In re Rath*, 402 F.3d 1207, 1211 (Fed. Cir. 2005).

167. See *Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d 462, 481 (2d Cir. 2005).

168. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 907 (9th Cir. 2002) (noting that sections 44(h) and (i) of the Lanham Act provide federal causes of action to the extent that the provisions of the Paris Convention create such rights).

169. See *Rath*, 402 F.3d at 1211.

170. See *Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. (BNA) 909, 924 (T.T.A.B. 1984).

171. See *Rath*, 402 F.3d at 1211; see also *Crocker Nat’l Bank*, 223 U.S.P.Q. (BNA) at 924.

to have extraterritorial reach, and that the articles of the Paris Convention should be fully executed. Judicial decisions have since recognized that article 6*bis*, as well as the provisions of other international treaties, should be understood as incorporated into the Lanham Act. The statute, therefore, has continued to develop with great emphasis on synchronicity with international law.

#### IV. COURTS SHOULD VIEW THE LANHAM ACT AS INCORPORATING THE WELL-KNOWN MARKS DOCTRINE

Courts should treat the Lanham Act as providing foreign well-known mark holders with remedies under federal law when their trademarks are infringed in the U.S. The plain language of sections 44(b), (h), and (i) of the Lanham Act mandates that federal trademark law give full effect to article 6*bis* of the Paris Convention.<sup>172</sup> The Lanham Act's legislative history indicates that courts should completely execute the protections afforded by article 6*bis* of the Paris Convention.<sup>173</sup> Congress thus clearly sought to incorporate the articles of the Paris Convention in the codification of federal trademark law.<sup>174</sup> Courts have accordingly held or implied that Lanham Act claimants may assert the well-known marks doctrine as a means of redress.<sup>175</sup> The conclusion that the Lanham Act adopted article 6*bis* is buttressed by the principle that trademark law, particularly in instances of uncertainty, should be interpreted in harmony with international law principles.<sup>176</sup>

##### A. *The Plain Language of Sections 44(b), (h), and (i) of the Lanham Act Reveals that the Paris Convention's Well-Known Marks Doctrine Is a Part of Federal Trademark Law*

A proper interpretation of the ordinary meaning of sections 44(b), (h), and (i) of the Lanham Act demonstrates that article 6*bis* of the Paris

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172. See 15 U.S.C. § 1126(b), (h)–(i) (2000).

173. See *Trademarks*, *supra* note 14; see also S. REP. NO. 79-1333, at 5 (1946), as reprinted in 1946 U.S. Code Cong. Serv. 1274, 1276.

174. See *Gen. Motors Corp. v. Ignacio Lopez de Arriortua*, 948 F. Supp. 684, 690 (E.D. Mich. 1996).

175. See *Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d 462, 480 (2d Cir. 2005); *Grupo Gigante II*, 391 F.3d 1088, 1094 (9th Cir. 2004); *ITC v. Punchgini, Inc.*, 373 F. Supp. 2d 275, 286–89 (S.D.N.Y. 2005); *Grupo Gigante I*, 119 F. Supp. 2d 1083, 1090 (C.D. Cal. 2000), *vacated*, 391 F.3d 1088 (9th Cir. 2004).

176. See, e.g., S. REP. NO. 100-515, at 5 (1988), as reprinted in 1988 U.S.C.C.A.N 5577, 5581.

Convention is an integrated part of federal trademark law. Unless confusion is evident from the text, the ordinary meaning of statutory language provides the complete means of interpretation for courts.<sup>177</sup> Sections 44(b) and (h) unequivocally enable foreigners to receive protection from unfair competition in the U.S.<sup>178</sup> Section 44(b) explicitly codifies the provisions of international conventions into the very fabric of the Lanham Act.<sup>179</sup> It is also significant to note that the original rendering of section 44(b) specifically referenced the Paris Convention.<sup>180</sup> In addition, the plain language of section 44(i) reinforces the notion that foreign nationals must receive the same rights as U.S. citizens under section 44(b).<sup>181</sup> Several jurisdictions have determined that the language of section 44(i) could only have been enacted in order to afford nationals of Paris Convention member nations additional rights beyond those explicit in the Lanham Act.<sup>182</sup> Therefore, the ordinary meaning of section 44(i) reveals congressional intent to entitle Lanham Act claimants to the rights embodied in international treaties.<sup>183</sup> If every clause and word within the statutory text is to be given full effect,<sup>184</sup> then the Lanham Act must provide claimants with the power to invoke any convention provision to which the U.S. is a party.<sup>185</sup> Thus, because the U.S. is a member nation of the Paris Convention, article 6*bis* of that convention must be understood to create a valid cause of action for Lanham Act litigants whose countries are signatories to the international treaty.

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177. See, e.g., *Consumer Prod. Safety Comm'n v. GTE Sylvania, Inc.*, 447 U.S. 102, 108 (1980).

178. See 15 U.S.C. § 1126(b), (h) (2000).

179. See *id.* § 1126(b) ("Any person whose country of origin is a party to any convention . . . to which the United States is also a party . . . shall be entitled to the benefits of this section . . . to the extent necessary to give effect to any provision of such convention . . .").

180. See *Havana Club Holding, S.A. v. Galleon, S.A.*, 62 F. Supp. 2d 1085, 1093 n.7 (S.D.N.Y. 1999).

181. See 15 U.S.C. § 1126(i).

182. See *Gen. Motors Corp. v. Ignacio Lopez de Arriortua*, 948 F. Supp. 684, 689 (E.D. Mich. 1996); see also *Maison Lazard et Compagnie v. Manfra, Tordella & Brooks, Inc.*, 585 F. Supp. 1286, 1289 (S.D.N.Y. 1984).

183. See *Gen. Motors Corp.*, 948 F. Supp. at 689.

184. See, e.g., *United States v. Menasche*, 348 U.S. 528, 538–39 (1955).

185. See 15 U.S.C. § 1126(b).



*B. The Legislative History of Sections 44(b) and (h) Evidence  
Congressional Intent to Recognize the Articles of the Paris  
Convention as a Part of the Lanham Act*

The Lanham Act's legislative history shows that Congress intended sections 44(b) and (h) to give full effect to the provisions of the Paris Convention.<sup>186</sup> Prior to the passage of the Lanham Act, lawmakers were aware of the greater rights provided by the Paris Convention.<sup>187</sup> Although initially skeptical of codifying such broad rights,<sup>188</sup> Congress created section 44(h) in order to give full effect to the provisions of the Paris Convention.<sup>189</sup> Even with recent amendments to the Lanham Act, Congress continues to emphasize that the interrelationship between federal law and the Paris Convention should not be altered.<sup>190</sup> Congress, therefore, was aware of the more expansive rights contained in the international convention and intended to endorse such rights through the provisions of section 44.<sup>191</sup>

*C. Courts Have Determined that International Conventions Provide  
Additional Rights and Remedies to Litigants by Way of Section 44  
of the Lanham Act*

Courts that find ambiguity within section 44 of the Lanham Act may also look to judicial and administrative interpretations of the statute to assist in their analyses.<sup>192</sup> In so doing, courts have recognized that the Lanham Act, since its inception, has served to broaden the scope of unfair competition law immensely.<sup>193</sup> The Ninth Circuit recently affirmed that foreign trademark owners may bring Lanham Act claims based entirely on article 6bis of the Paris Convention.<sup>194</sup> The *Grupo Gigante* court stressed that the Paris Convention is not self-executing

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186. See *Trademarks*, *supra* note 14; see also S. REP. NO. 79-1333, at 5 (1946), as reprinted in 1946 U.S. Code Cong. Serv. 1274, 1274-78.

187. See *Trademarks*, *supra* note 14.

188. See *id.* at 165-68.

189. See *Gen. Motors Corp. v. Ignacio Lopez de Arriortua*, 948 F. Supp. 684, 690 (E.D. Mich. 1996).

190. See S. REP. NO. 100-515, at 5 (1988), as reprinted in 1988 U.S.C.C.A.N 5577, 5581.

191. See *Gen. Motors Corp.*, 948 F. Supp at 690.

192. See, e.g., *Montgomery v. Huntington Bank*, 346 F.3d 693, 699 (6th Cir. 2003).

193. See, e.g., *Vaudable v. Montmartre*, 193 N.Y.S.2d 332, 335 (Sup. Ct. 1959).

194. See *Grupo Gigante II*, 391 F.3d 1088, 1099 (9th Cir. 2004).

and thus does not generate particular rights in federal courts.<sup>195</sup> Therefore, protection for foreign well-known marks emanates from federal law.

Although the Southern District of New York declined to recognize the well-known marks doctrine absent an explicit amendment to the Lanham Act,<sup>196</sup> it did not properly construe the plain meaning of section 44(b). Section 44(b) aims to give effect to article 6*bis* of the Paris Convention.<sup>197</sup> Therefore, the mere fact that the Lanham Act does not spell out the well-known marks doctrine in its text is irrelevant because section 44(b) plainly offers Lanham Act protection when rights are asserted under international trademark conventions.<sup>198</sup> Even though the Southern District of New York ultimately found conflict between Congress' specified bases for federal trademark claims and section 44(b), an analysis of relevant legislative history confirms the proper conclusion.<sup>199</sup> Moreover, the court declined to follow the Second Circuit's suggestion that the well-known marks doctrine may be an integral part of sections 44(b) and (h) of the Lanham Act outside of a case involving the Cuban embargo.<sup>200</sup> Based on language embedded in the decision, it seems probable that, had the embargo been set aside, the Second Circuit would have granted relief under the well-known marks doctrine through a Lanham Act claim.<sup>201</sup> Consequently, the refusal of the Southern District of New York to validate the well-known marks doctrine provides an unpersuasive construction of federal trademark law.

The Ninth Circuit's recognition that other international treaties also provide additional substantive rights under section 44(b) of the Lanham Act further supports the conclusion that the Lanham Act incorporates

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195. *See id.* at 1100.

196. *See Almacenes Exito S.A. v. El Gallo Meat Mkt., Inc.*, 381 F. Supp. 2d 324, 328 (S.D.N.Y. 2005).

197. *See* 15 U.S.C. § 1126(b) (2000).

198. *See id.*

199. *See Gen. Motors Corp. v. Ignacio Lopez de Arriortua*, 948 F. Supp. 684, 690 (E.D. Mich. 1996).

200. *See Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d 462, 480–81 (2d Cir. 2005).

201. *See id.* ("Cubatabaco may be correct that Sections 44(b) and (h) incorporate Article 6*bis* and allow foreign entities to acquire U.S. trademark rights in the United States if their marks are sufficiently famous in the United States before they are used in this country . . . . However, we need not decide that broad question here because even assuming that the famous marks doctrine is otherwise viable and applicable, the embargo bars Cubatabaco from acquiring property rights in the U.S. COHIBA mark through the doctrine.").

article 6*bis* of the Paris Convention into federal law.<sup>202</sup> The *Toho* court determined that section 44 requires courts to consider provisions of international law when deciding whether a foreign trademark owner may assert a Lanham Act claim.<sup>203</sup> Moreover, the basic premise of the trademark treaty at issue in *Toho*, reciprocal treatment between Japan and the U.S.,<sup>204</sup> is identical to the reciprocal treatment mandated by the Paris Convention.<sup>205</sup> In this crucial regard, the international agreements are indistinguishable.<sup>206</sup> Thus, any claim brought under section 44(b) necessitates careful consideration of relevant international provisions such as the well-known marks doctrine.

*D. Under the Charming Betsy Canon, Courts Should Construe the Lanham Act in Harmony with International Law*

The *Charming Betsy* canon of construction mandates that courts interpret the Lanham Act in accordance with the articles of the Paris Convention.<sup>207</sup> Section 44(b) of the Lanham Act aims to give effect to all provisions of international trademark conventions.<sup>208</sup> Since the language of the statute serves to reinforce rather than contradict the provisions of the Paris Convention, courts should construe relevant portions of the Lanham Act in a manner consistent with those rights enumerated in international treaties in order to comply with the *Charming Betsy* canon.<sup>209</sup> Both federal and administrative courts have utilized this canon to harmonize section 44 of the Lanham Act with the Paris Convention.<sup>210</sup> Thus, if a court finds section 44 to contain an ambiguity, it should avoid construing the statute in any manner that fails to give full effect to international provisions such as the well-known marks doctrine.<sup>211</sup>

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202. See *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788, 792–93 (9th Cir. 1981).

203. See *id.*

204. See Treaty of Friendship, Commerce and Navigation, U.S.-Japan, art. X, Apr. 2, 1953, 4 U.S.T. 2063, 2071.

205. See Paris Convention, *supra* note 7, art. 2.

206. Compare *id.*, with Treaty of Friendship, Commerce and Navigation, U.S.-Japan, art. X, Apr. 2, 1953, 4 U.S.T. 2063, 2071.

207. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. (BNA) 909, 924 (T.T.A.B. 1984).

208. See 15 U.S.C. § 1126(b) (2000).

209. Cf. *Murray v. Schooner Charming Betsy*, 6 U.S. (2 Cranch) 64, 118 (1804).

210. See *In re Rath*, 402 F.3d 1207, 1211 (Fed. Cir. 2005); *Crocker Nat'l Bank*, 223 U.S.P.Q. (BNA) at 924.

211. See *Crocker Nat'l Bank*, 223 U.S.P.Q. (BNA) at 924.

In sum, federal courts should interpret section 44(b) of the Lanham Act as codifying article 6bis of the Paris Convention. The plain language of sections 44(b), (h), and (i), read in concert, provides Lanham Act claimants with additional rights founded upon the provisions of international conventions. Examination of legislative history and prior judicial considerations of the statute also reveals that international conventions offer substantive rights and a means of redress under the Lanham Act. Moreover, under the *Charming Betsy* canon, the Lanham Act must be interpreted in accordance with international law. Consequently, a proper interpretation of the Lanham Act incorporates article 6bis of the Paris Convention.

## V. CONCLUSION

The plain language, legislative history, and prior considerations of the Lanham Act all require courts to recognize the well-known marks doctrine as an integrated part of the Lanham Act. Congress would not have enacted sections 44(b), (h), and (i) of the Lanham Act unless it intended additional rights founded upon international conventions to be made available to Lanham Act claimants. Moreover, proper interpretation of the Lanham Act in accordance with relevant international conventions would reduce inconsistencies between U.S. and international laws, thereby promoting innovation and global trade<sup>212</sup> while allowing all signatory nations to develop industries in a manner that strengthens the ability of their domestic mark holders to receive valuable trademark protection in the U.S. Unless courts consider article 6bis of the Paris Convention and other similar international accords to be incorporated in the Lanham Act, courts will improperly render the relevant statutory provisions obsolete. Such a result would be antithetical to prescribed notions of statutory construction.

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212. See Graeme B. Dinwoodie, *Essay: The Integration of International and Domestic Intellectual Property Lawmaking*, 23 COLUM.-VLA J.L. & ARTS 307, 308–10 (2000).

